

STATUS OF CLAIMS

Claims 1-30 are pending.

Claims 11 and 24 stand objected to by the Examiner.

Claims 1-30 stand rejected by the Examiner.

Claims 11, 15 and 24 have been amended, without prejudice, herein.

REMARKS

Reconsideration of the present Application is respectfully requested.

Objections to Claims 11 and 24

Claims 11 and 24 have been objected to by the Examiner for informalities related to typographical errors. Specifically, the term “band” was incorrectly spelled as “ban”. Applicant respectfully submits Claims 11 and 24, as amended, correct these errors.

Objections to the Drawings

The drawings have been objected to by the Examiner because they are not in compliance with 37 C.F.R. 1.121(d). Specifically, in Figure 4b the term “unque” should be correctly spelled. Applicant respectfully submits the amended drawing is in compliance with 37 C.F.R. 1.121(d).

Rejections based on 35 U.S.C. § 103 (a)

Claims 1-3, 6, 9-10, 15-16, 19, 22-23 and 25-26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen (U.S. Patent No. 6,628,939) in view of Tendler (U.S. Patent No.

6,778,820). Claims 27-30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen and Tendler, in further view of Walker et al. (U.S. Patent No. 6,527,638). Claims 4-5, 7-8, 17-18 and 20-21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen and Tendler, in further view of Clapper (U.S. Patent Application Publication No. 2002/0168967). Claims 11, 13 and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen and Tendler, in further view of Kotzin et al. (U.S. Patent No. 6,470,180). Claim 12 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen, Tendler and Kotzin, in further view of Thiriet (U.S. Patent No. 6,650,892). Claim 14 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin, in further view of Tendler. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits the cited references fail to teach or suggest at least each of the limitations of independent Claims 1, 14 and 15, either alone or in combination.

Regarding Claim 1, Applicant respectfully submits that none of the cited references, either separately or in combination, teach or suggest commencing game play by causing **an activation signal** to be received and processed, and wherein the player device is placed in condition to receive said activation signal by the device's first location being within a bounded authorized area, as recited in Claim 1. Applicant agrees with the Examiner that Paulsen fails to disclose the player device is placed in condition to receive said activation signal by the device's first location being within a bounded authorized area. However, Applicant respectfully submits the present Office Action mischaracterizes Paulsen at Column 8, line 65 to Column 9, line 11, where it states "Once verification has been provided of the player's bet or ante, the player may be permitted to play the game...". Within the context of the disclosure of Paulsen, the device in Paulsen merely requires selection of a wager amount, which must be verified for available credit by a server. After verification, the player is permitted to play the game. In fact, Paulsen does not teach or suggest an activation signal at all. Thus, the verification process in Paulsen only verifies whether the user of the device has sufficient available funds in their account before game play, whereas the activation signal in the present invention is sent after verification of the device's first location being within a bounded authorized area.

The present Office Action also mischaracterizes Tendler at Column 3, line 66 to Column 4, line 5, where it states "In order to ascertain whether or not the wagering party or individual is within the authorized geographic location, for instance, the state of Nevada, the location is decoded at 34 and a map 36 is driven by a drive unit 38 so as to indicate the location of the caller as indicated by 40 on a map 42 which has an outline of geographic boundary of the wagering jurisdiction as illustrated at 44." Thus, Tendler discloses only decoding a location and indicating this location on a

map, and **not** the causing of an activation signal to be received and processed. In fact, **Tendler does not disclose an activation signal at all**, no less a player device causing such a signal to be received and processed based on the device's first location being within a bounded authorized area.

As described in the Specification of the present invention in paragraphs 59 and 60, and depicted in Figures 5 and 5b, once the data source has approved the consumer's registration information, the system schedules the card's activation through a secure, RF broadcast network. At the next available opportunity, the network node directs a regional broadcast station most proximate to the customer's present location, ***to broadcast a set of encrypted commands which activate the device*** identified by the respective device serial number. Once the activation signal is detected and processed by the device's RF receiver and microprocessor, the device, under operational software control, prompts the consumer to enter their PIN number for confirmation and subsequent manipulation of credit amount.

Regarding Claim 14 and amended Claim 15, for the same reasons as discussed above, the cited references do not teach or suggest activation of the gaming device, based on the device's first location being within a bounded authorized area, prior to game play. As stated by the Examiner, Kotzin fails to disclose the gaming device is activated for game play. Walker and Thiriet similarly fail to disclose the gaming device is activated for game play.

Thus, Applicant respectfully submits the cited references, either separately or in combination, fail to teach or suggest an activation signal based on the device's first location being within a bounded authorized area, prior to game play, as found in Claims 1, 14 and 15. Applicant further submits that Claims 2-13 and 16-30 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from a patentably distinct base claim.

Applicant also respectfully submits there is no reason to combine the teachings of the cited references. The teaching or suggestion to make the claimed combinations and the reasonable

expectation of success must both be found in the prior art and not based on an applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). More specifically, MPEP 2144.08

(II)(A) states:

To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) ("[T]he mere possibility that one of the esters or the active methylene group-containing compounds... could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious 'unless the prior art suggested the desirability of [such a] modification' or replacement.") (quoting In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)); In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) ("[A] proper analysis under 103 requires, *inter alia*, consideration of . . . whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process."). In order to find such motivation or suggestion there should be a reasonable likelihood that the claimed invention would have the properties disclosed by the prior art teachings. . . . See, e.g., Vaeck, 947 F.2d at 493, 20 USPQ2d at 1442 (A proper obviousness analysis requires consideration of "whether the prior art would also have revealed that in so making or carrying out [the claimed invention], those of ordinary skill would have a reasonable expectation of success.")

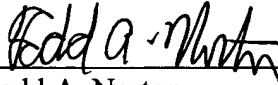
Applicant further submits that there is no motivation in the prior art to combine these teachings. As set forth hereinabove, an office action must set forth some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., *In re Brouwer*. Applicant respectfully requests Examiner set forth the motivation to combine any of the cited references, in their teachings, and not rely on Applicant's disclosure. Applicant respectfully submits that because none of the cited references teach the activation of the gaming device, based on the device's first location being within a bounded authorized area, prior to game play, this discrepancy highlights the fact that there is no reason to combine these references.

CONCLUSION

Wherefore, Applicant believes that all outstanding grounds raised by the Examiner have been addressed and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,

Date: February 8, 2005


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Please enter the following amendments and remarks:

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Figure 4b. This sheet, which includes Figures 4b and 5b, replaces the original sheet including Figures 4b and 5b. In Figure 4b, the term “unque” has been replaced by the term “unique”.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

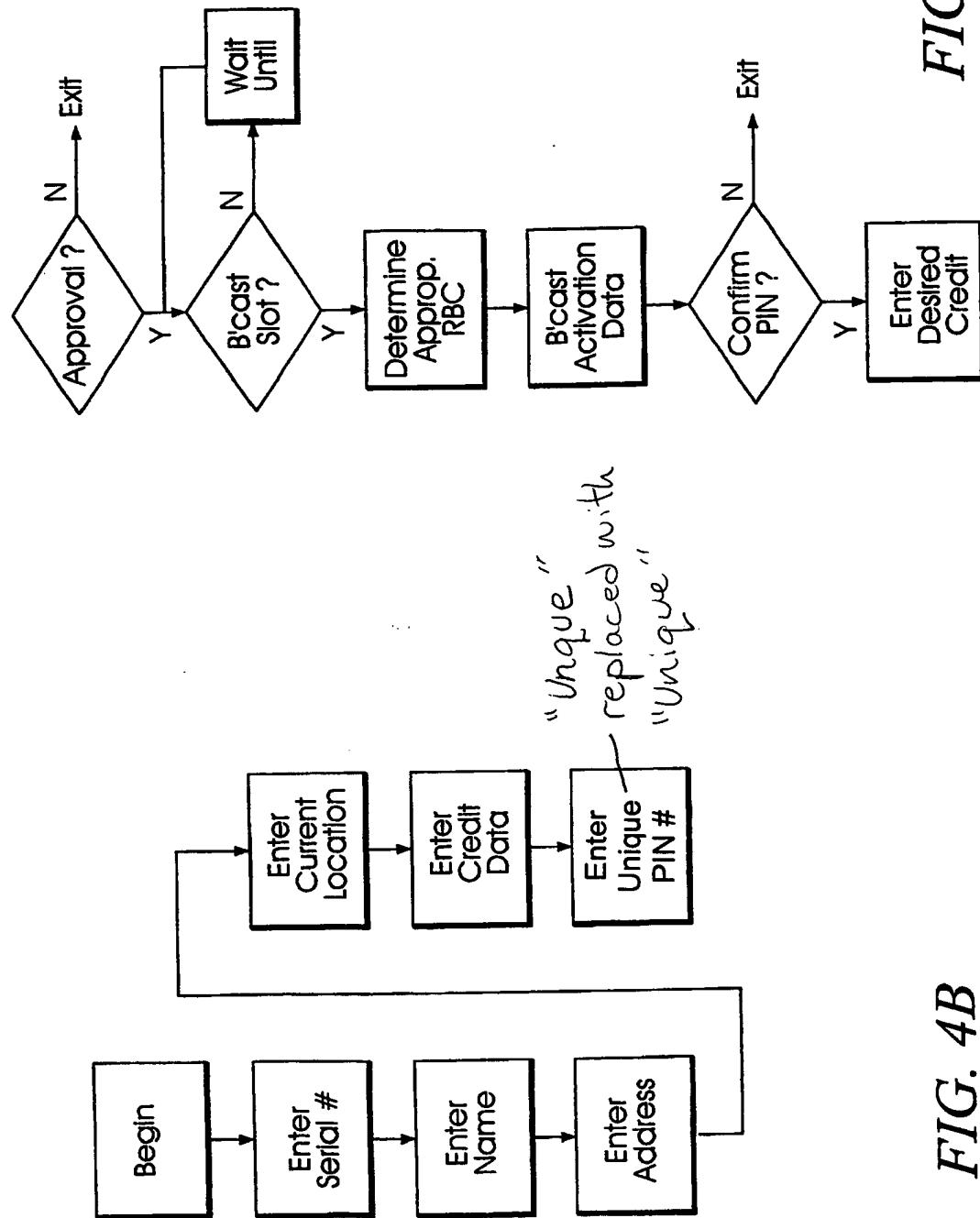


FIG. 4B

FIG. 5B